



08-14-02 #11 1731

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Denis John Albert

Serial No.: 09/763,511

Filed: May 22, 2001

Title: METHOD OF SELECTING AND/OR  
PROCESSING WOOD ACCORDING TO FIBRE  
CHARACTERISTICS

Examiner:

Group Art Unit: 1731

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TRANSMITTAL

Transmitted herewith is/are: Transmittal: REsponse to Restriction Requirement in Office Action of June 12, 2002 (3 pgs); and return postcard. This/These document(s) is/are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on August 16, 2002.

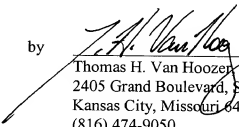
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Respectfully submitted,

HOVEY WILLIAMS LLP

by

  
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ATTORNEYS FOR APPLICANT

(Docket No. 31386)



Express Mail No. EV 116071603 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

#11/8.2/02

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ALBERT, Denis John et al. )  
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TO FIBRE CHARACTERISTICS )

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Examiner: Alvo, Marc S.

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Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Office Action dated June 12, 2002, applicant provisionally elects to prosecute those claims identified in the Office Action as Group II, i.e. claims 9-12 and 29-30, with traverse.

The examiner has correctly noted that in this application filed as a national phase application under 35 U.S.C. §371, the provisions of PCT 13 apply regarding unity of invention, rather than the provisions of 37 C.F.R. §1.141. PCT Rule 13.1 permits one invention or a group of inventions "so linked as to form a single general inventive concept." PCT rule 13.2(ii) specifically indicates that Rule 13.1 "shall be construed as permitting, in particular, one of the following three possibilities: (ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed

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for carrying out the said process". In the present application, the apparatus claims 9-12 and 29-30 are specifically designed for carrying out the process of predictively assessing at least one characteristic of wood fibre or wood pulp, this process being carried out in the claims identified in Group I. Moreover, the claims share the same technical feature of assessing the properties of predictively assessing a characteristic of wood fibre or wood pulp to be produced with reference to the sound velocity through the wood. The determination of a common special technical feature is not assessed after examination, for that would make the unity of invention rules pointless. To examine the application, determine patentability, then apply the unity of invention rules is both a backwards process and inefficient, for once the claims have been examined, there is no point in imposing a restriction requirement. This is especially true in this case where both process and apparatus claims have already been examined. It is thus apparent that the Office considered that there was unity of invention in the first instance. Moreover, applicant believes the cited reference U.S. Patent 5,224,381 only teaches the use of sound velocity in assessing wood *in situ* and does not in any way teach or suggest how the use of sound predictively assesses the qualities of wood pulp or wood fibre. Reconsideration of the reference and the restriction requirement is thus courteously requested.

Accordingly, early issuance of the Notice of Allowance is courteously requested. Should any additional fees be due in connection with this submission, they may be charged to deposit account 19-0522. Any issues which remain and may be resolved by a telephone conference may directed to the undersigned at 1-800-445-3460.

Respectfully submitted,

HOVEY WILLIAMS LLP

By 

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